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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COBANOGLU, DILEK B

ART UNIT PAPER NUMBER

3626

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/939,380

Applicant(s)

TRITCH ET AL.

Examiner

Dilek B. Cobanoglu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08/24/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-17 have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 2 and 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. The basis of this rejection is set forth in a two-prong test of:

- (1) Whether the invention is within the technological arts, or
- (2) the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the claims only recite an abstract idea.

Exemplary claim 1 recites a method comprising: providing a medical directive form to an individual and a third party; individual

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executes the form; and collecting the form. However, there is no requirement within the recited means to positively and definitely require the technological arts. For example, "providing a form" means may be nothing more than a form provided by an employee of a company, such as in the registration, to the customer or to an individual. Also, the "individual executing the form" can be done by paper and pen. An employee who is doing the registration can perform the "collecting the form". As such, it is respectfully submitted that the claimed system and method is not within the technological arts.

Similar analysis holds for method claim 2 and 15.

Also in claim 15, the method for storing the medical directives or forms can be done by storing them in a paper file cabinet.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry et al. (U.S. Patent No. 5,241,466) in view of Johnson et al. (U.S. Patent No. 5,664,109).

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A. As per claim 1, Perry et al. discloses a method of storing and retrieving advance medical directives or living wills (Perry et al.; abstract), comprising:

a) providing an advance medical directive form or an application (Perry et al.; col.3, lines 47-53) to a third party entity responsible for payment of medical services;

Perry et al. fails to expressly teach to provide a form or an application to a third party entity, per se, since it appears that Perry et al. is more directed to provide a form or an application to an individual or a customer. However, this feature is well known in the art, as evidenced by Johnson et al.

In particular, Johnson et al. discloses a central medical record repository for a managed health care organization accepts and stores medical record documents in any format from medical service providers (Johnson et al.; abstract), wherein the medical service providers include insurance companies or third party entities (Johnson et al.; col. 4, lines 41-46).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined providing a form or an application for medical directives or living wills disclosed by Perry et al. within the service providers include

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insurance companies or third party entity taught by Johnson et al. with the motivation of to collect all of patient's medical records into a central location for access by health care managers and providers, which are the third parties (Johnson et al.; col. 4, lines 41-46).

b) subsequent to step a), providing said advance medical directive an application form to an individual or a customer for whom said third party entity or insurance company is responsible for payment of medical services (Perry et al.; col. 3, lines 47-53);

c) said individual executing said advance medical directive form (Perry et al.; col. 4, lines 51-59);

Examiner considers sending completed application form and a will has the same meaning as executing the directive since the customer has to execute when sending such legal document.
and

d) collecting said advance medical directive for later retrieval (Perry et al.; col. 4, lines 59-62).

B. As per claim 2, Perry et al. discloses the method of claim 1, wherein said step of providing said advance medical directive to an individual comprises providing an integrated packet of forms including said advance medical directive form or application form, testamentary will (Perry et al.; col. 4, lines 51-59).

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C. As per claim 3, Perry et al. discloses the method of claim 1 (Perry et al.; abstract), further comprising the steps of:

organizing said advance medical directive forms for later retrieval (Perry et al.; col. 5, lines 1-3); or creating files for

providing a central depository for storing a plurality of executed advance medical directives (Perry et al.; col. 3, lines 19-24);

scanning said executed advance medical directives into a plurality of computer files (Perry et al.; col. 3, lines 51-53);

storing said plurality of computer files in said central depository (Perry et al.; col. 3, lines 47-48 and lines 58-61); and

retrieving said plurality of executed advance medical directives via a query system (Perry et al.; col. 4, lines 62-66).

D. As per claim 4, Perry et al. discloses the method of claim 3, wherein said central depository comprises a database (Perry et al.; col. 2, lines 38-40).

E. As per claim 5, Perry et al. discloses the method of claim 3, wherein said query system comprises a telephone response system (Perry et al.; col. 2, lines 44-47).

F. As per claim 6, Perry et al. discloses the method of claim 3, wherein said query system comprises a computer network interface or a computerized system (Perry et al.; col. 4, lines 59-66).

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G. As per claim 7, Perry et al. discloses the method of claim 3, further comprising the step of recording data to be used for purposes of billing (Perry et al.; col. 4, lines 43-45).

H. As per claim 8, Perry et al. discloses the method of claim 3, further comprising the step of transmitting the selected advance medical directive to a desired destination (Perry et al.; col. 2, lines 44-54).

I. As per claim 9, Perry et al. discloses the method of claim 8, wherein said desired destination comprises at least one of a facsimile machine and a computer (Perry et al.; col. 2, lines 44-54).

J. As per claim 15, Perry et al. discloses a method of storing and retrieving advance medical directives or living wills (Perry et al.; abstract and col.2, lines 31-36) comprising:

providing an advance medical directive form to an individual (Perry et al.; col. 3, lines 54-57);

said individual executing said advance medical directive form (Perry et al.; col. 3, lines 54-57);

and storing said advance medical directive in a central depository (Perry et al.; abstract) controlled by a third party entity responsible for payment of medical services.

Perry et al. fails to expressly teach a central depository controlled by a third party entity which is responsible for payment of medical services, per se, since it appears that Perry et al. is more directed to store and retrieve information

for authorized requestors (Perry et al.; col.2, lines 18-20)

However, this feature is well known in the art, as evidenced by Johnson et al.

In particular, Johnson et al. discloses a central medical record repository for a managed health care organization accepts and stores medical record documents in any format from medical service providers (Johnson et al.; abstract), wherein the medical service providers include insurance companies or third party entities (Johnson et al.; col. 4, lines 41-46).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined storing and retrieving information for authorized requestors disclosed by Perry et al. within the service providers include insurance companies or third party entity which is responsible for the medical services taught by Johnson et al. with the motivation of to collect all of patient's medical records into a central location for access by health care managers and providers, which are the third parties (Johnson et al.; col. 4, lines 41-46).

K. As per claim 16, Perry et al. discloses the method of claim 15, wherein said step of storing said advance medical directive comprises the steps of:

scanning said executed advance medical directives into a plurality of computer files (Perry et al.; col.3, lines 51-53 and lines 59-61) and storing said plurality of computer files in said central depository (Perry et al.; col.3, lines 58-64).

As per claim 17, Perry et al. discloses the method of claim 16, further comprising the step of retrieving said plurality of said executed advance medical directives via a query system (Perry et al.; col.4, lines 6266).

7. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry et al. (U.S. Patent No. 5,241,466) in view of D'Alessio et al. (U.S. Patent No. 5,441,309).

A. As per claim 10, Perry et al. discloses a system for storing and retrieving advance medical directives (Perry et al.; abstract), comprising:

a database for storing a plurality of electronic files containing executed advance medical directive forms (Perry et al.; col.2, lines 38-42), said advance medical directive forms including a plurality of bubbles corresponding to a set of digits and letters, wherein each of said bubbles are filled by an executor according to each of said digits and each of said letters of a specified index;

Perry et al. fails to expressly teach the plurality of bubbles, per se, since it appears that Perry et al. is more directed to provide a an optical storage device connected to an optical

scanner. However, this feature is well known in the art, as evidenced by D'Alessio et al.

In particular, D'Alessio et al. discloses forms of data that is in a format usable by machines (D'Alessio et al.

; abstract and col.1, lines 23-25), wherein the bubble areas with letters that correspond to particular answers (D'Alessio et al.; col. 1, lines 53-55).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined optical storage device connected to an optical scanner disclosed by Perry et al. within the bubble areas that correspond to a particular answer taught by D'Alessio et al. with the motivation of to use the high speed and accuracy of computer automation to simplify business transactions (D'Alessio et al.; col. 1, lines 25-27).

a scanner for scanning said executed advance medical directive forms (Perry et al.; col.3, lines 51-53);

a computational device operably connected to said scanner and said database (Perry et al.; col.2, lines 37-39), said computational device controlling said scanner and generating said electronic files containing said executed advance medical directive forms for transmission to said server (Perry et al.; col.3, lines 58-64), said computational device operable to read said filled bubbles to determine said specified index, said server

indexing said electronic files containing said advance medical directive forms with said specified index; an interface including a query system for retrieving a selected advance medical directive; and means for transmitting said selected advance medical directive from said database.

The obviousness of modifying the teaching of Perry et al. to include the bubble areas (as taught by D'Alessio et al.) is as addressed above in the rejection of first part of claim 10 and incorporated herein.

B. As per claim 11, Perry et al. discloses the system of claim 10, wherein said specified index comprises an executor's social security number (Perry et al.; col.4, lines 51-59).

C. As per claim 12, Perry et al. discloses the system of claim 10, wherein said means for transmitting comprises a facsimile machine (Perry et al.; col.2, lines 44-47).

D. As per claim 13, Perry et al. discloses the system of claim 10, wherein said means for transmitting comprises a computer (Perry et al.; col.3, lines 54-57).

E. As per claim 14, Perry et al. discloses the system of claim 10, wherein said means for transmitting comprises a fax server (Perry et al.; col.9, lines 1-3).

Conclusion

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied arts teach a "Virtual home data repository and directory (2001/0051883)", "Will information management and disclosure system and method, and program storage medium thereof (6,246,991)", and non-patent literatures such as "Will maker helps you plan for the future" by Don Crabb from Chicago Sun-Times (page 29, Jan 30, 1997), "New web site helps people address care planning and end-of-life care issues" by PR Newswire, New York (page 1, Aug 31, 2000) and "Are you too young to need a living will? Probably not" by Palm Beach Post (Nov 24, 1997).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dilek B. Cobanoglu
Art Unit 3626
Business Methods

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